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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,768	07/31/2001	Jeffry J. Grainger	020313-000530US	4992
20350 7590 01/24/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER MOONEYHAM, JANICE A	
			ART UNIT 3629	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			01/24/2007	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/919,768

Applicant(s)

GRAINGER ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on November 7, 2006, wherein:

Claims 1-12 and 14-22 are currently pending;

Claims 1, 2, 6-12, and 14-19 have been amended;

Claims 20-22 are new;

Claim 13 has been cancelled.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on June 23, 2006 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 and 14-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

First, the term citation document is a broad concept and could encompass a traffic ticket.

Secondly, it is unclear what applicant is claiming as the inventive concept. Dependent claim 2 states that wherein the displayed citation information includes information about one or more prior art reference

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documents submitted to a patent office and indication of whether or not each prior art reference document was considered by the patent office and the input received from the user indicates whether or not the first reference was considered by the patent office. Therefore, it is not clear what documents are being processed or how they are being processed. Is the inventive concept merely storing the IDS statements processed by the patent office and displaying these IDS statements? If so, this is contradictory to claim 1 wherein it states that a first reference comprising a set of reference information ***to be disclosed*** to a patent office, which indicates a future event.

4. Claim 21 is rejected under 35 U.S.C. § 112, first paragraph, as being of undue breadth.

A "single means" claim, i.e. where a means recitation does not appear in combination with another recited element or means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. See *In re Hyatt*, 218 USPQ 195, (CAFC 1983) and MPEP 2164.08(a).

2164.08(a) Single Means Claim

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A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in Fiers v. Sugano, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim.

Claim 21 only defines a processor. It takes more than a processor to execute the instructions of the computer-readable medium.

5. Claims 1-12 and 14-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claim 1 and added claims 21-22, all having the following limitations:

displaying identifiers in a second display section, an identifier corresponding to the first reference;

providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.

It is unclear what the applicant is claiming in these limitations.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 states as follows:

Non-statutory Subject Matter

- Claims to computer-related inventions that are clearly non-statutory fall into the same general categories as non-statutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "**descriptive material**." □P8□
- **Descriptive material** can be characterized as either "**functional descriptive material**" or "**nonfunctional descriptive material**." □P8□
- "**Functional descriptive material**" consists of data structures and computer programs which impart functionality when encoded on a computer-readable medium. □P8□
- "**Nonfunctional descriptive material**" includes but is not limited to music, literary works and a compilation or mere arrangement of data. □P8□
- Both types of "**descriptive material**" are Non-statutory when claimed as **descriptive material per se**. When functional descriptive material is **recorded on some computer-readable medium** it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. □P8□
- When nonfunctional descriptive material is recorded on some computer-readable medium, it is not structurally and functionally interrelated to the medium but is **merely carried by the medium**. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. □P8□
- - (a) **Functional Descriptive Material: "Data Structures"**
Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se □P9□
- **Data structures** not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical

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"things" nor statutory processes. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. □P9□

- In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the medium which permit the data structure's functionality to be realized, and is thus statutory. □P9□
- Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things," nor are they statutory processes, as they are not "acts" being performed. □P9□
- In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. □P9□
- **Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process** and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as Non-statutory functional descriptive material. □P9□
- When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. □P10□
- When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. □P10□

(b) Nonfunctional Descriptive Material

- Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. □P10□

Claim 22, as written, is claiming only instructions. Thus, the claim is not statutory.

To render the claim statutory, the applicant may amend to define the invention as:

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A computer software program embodied on a computer-readable medium, the computer software program comprising a set of instruction that when executed by a computer cause the computer to perform the steps of:

storing a plurality of references;

receiving;

displaying...

NOTE: The Examiner finds that because claim(s) 1-12 and 14-22 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12, 14, and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Porcari (US 2001/0037460).

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Referring to Claim 1:

Porcari discloses a computer implemented method of processing documents received on a server system comprising:

storing a plurality of first electronic documents on the server system, the plurality of first electronic documents containing reference information to be disclosed to a patent office [0058];

receiving a second electronic document on the server system, the second electronic document including citation information for one or more prior art reference documents [0056];

displaying the citation information in the second electronic document to a user of a client system in a first display section [0056-0058]; and

displaying a plurality of identifiers and one or more input select elements in a second display section, each of the plurality identifiers corresponding to one of the plurality of first electronic documents [0058],

wherein the user enters information into the server system using the input select elements, the information corresponding to the relation between the displayed citation information and the displayed plurality of identifiers [0056-0058].

Referring to Claim 2

Porcari discloses wherein the displayed citation information includes one or more references submitted to a patent office and an indication of whether or not each reference was considered by the patent office, and the information entered by the user indicates whether or not each of the plurality of identifiers corresponding to the first

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electronic documents were considered by the patent office [0056-0058].

Referring to Claim 3:

Porcari discloses wherein displaying the citation information includes displaying an image file of a form received from a patent office [0056].

Referring to Claims 4-5:

Porcari discloses wherein the form is a notice of references cited [0056].

Referring to Claim 6:

Porcari disclose wherein displaying a plurality of identifiers comprises displaying a plurality of patent numbers associated with a case [0056-0058].

Referring to Claim 7:

Porcari discloses wherein identifiers are United States Patent numbers [0058].

Referring to Claim 8.

Porcari discloses wherein identifiers are foreign patent numbers [0058].

Referring to Claim 9:

Porcari disclose wherein identifiers are serial numbers of patent publications.

Referring to Claim 10:

Porcari discloses wherein displaying a plurality of identifiers comprises displaying a plurality of publication titles [0058].

Referring to Claim 11:

Porcari disclose wherein the identifiers are links to the electronic documents [0056-0058].

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Referring to Claim 14:

Porcari discloses wherein the displayed citation information includes one or more references.

Referring to Claim 16:

Porcari discloses wherein an electronic document is received by electronic mail [0029] [0033].

Referring to Claim 17:

Porcari discloses wherein at least one of the plurality of first electronic documents on the server system is an electronic version of a United States Patent {0056-0058}.

Referring to Claim 18:

Porcari discloses herein at least one of the plurality of first electronic documents on the server system is an electronic version of a foreign patent document [0056].

Referring to Claim 19:

Porcari discloses wherein at least one of the plurality of first electronic documents on the server system is an electronic version of a publication [0058].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcari.

Referring to Claim 12:

Porcari discloses an approval log which indicates that approval has been obtained from each co-inventor as to a document (Figure 3 (126) and [0015] [0033]).

Porcari does not disclose wherein the input select elements include a yes check box and a no check box pair for each of the plurality of identifiers, and wherein when the yes check box is mouse clicked by the user, the information indicates that the identifier corresponding to the yes check box has been considered by a patent office, and when the no check box is mouse clicked by the user, the information indicates that the identifier corresponding to the no check box has not been considered by the patent office.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a check box for approving whether a document has been reviewed or considered as a means for docket management.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porcari as applied to claim 14 above, and further in view of Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette).

Referring to Claim 15:

Porcari discloses the method set forth in claim 14.

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Porcari does not disclose wherein the input select element is an electronic add button, and in accordance with mouse clicking the electronic add button, the information is entered by loading an electronic document from an external source.

However, Rivette discloses wherein the input select element is an electronic add button, and in accordance with mouse clicking the electronic add button, the information is entered by loading an electronic document from an external source [0292] [0396] [1192-1193].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the information disclosure statement method of Porcari the ability to add a document as disclosed in Rivette so as to be able to automatically and simultaneously correlate multiple patents.

Response to Arguments

Applicant's arguments filed November 7, 2006 have been fully considered but they are not persuasive.

As to applicant's arguments as to the prior art reference Porcari, the applicant states that Porcari fails to teach or suggest the use of multiple display sections. The Examiner does not find the multiple display sections claimed in claim 1.

As for the interface element configured to receive, from the user, input, a keyboard or a mouse would read on this limitation.

As stated above, under 35 USC 112, 2nd paragraph, it is not clear what aspect the applicant's invention is directed to. It is not clear how the invention allows a user to indicate whether a particular reference has been considered by the patent office.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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